

# Office Action Summary

Application No.

09/037,128

Applicant(s)

Schoon et al

Examiner

Faulkner, D.

Group Art Unit

1617



☒ Responsive to communication(s) filed on Nov 18, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-23 and 25-30 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-23 and 25-30 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

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Claims  
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112- Applicant  
should limit

### DETAILED ACTION

1. The examiner acknowledges receipt of the amendment and response received on 11/18/99.

#### *Claim Objections*

2. Claim 25-30 are objected to because of the following informalities: The applicant has not included a claim numbered as 24. The applicant has attempted to add in a new claim numbered as 24, however the claims have been renumbered under rule 126. New claim 24 is claim 31. Appropriate correction is required.

Wrong

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-23 and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pagano, WO 97/42930 in view of Beaver et al, US patent 5,830,442.

Pagano teaches a nail composition which comprises a combination of various alkyl methacrylates.

Pagano teaches a combination of various alkyl methacrylates including such methacrylates

represented from methyl methacrylate and butyl methacrylate, with muticarbonyl vinyl monomers

such as acetoacetoxyethyl methacrylate and with acrylic acids, additional plasticizers, solvents,

and U.V. absorbers in a nail composition.

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Pagano does not teach the particular tertiary amine accelerators, nor the use of these methacrylates, plasticizers and solvents in an artificial fingernail.

The claims differ in that applicant requires a thickness of at greater than 10 mils.

Beaver teaches that the nail compositions may be used to create a nail of the desired length, thickness and shape, see col. 2 lines 19-22. This limitation encompasses applicants thickness of greater than 10 mils, since Beaver describes that any thickness and shape may be used.

Beaver also teaches artificial nail compositions that comprise ethylenically unsaturated monomers with acetoacetoxyethyl methacrylate, ethylene glycol dimethacrylates. He teaches the addition of accelerators that are aliphatic tertiary amines such as an N,N-di lower alkyl p-toluidine. Beaver includes in his nail compositions. See examples 4-8, 16 and 18-21. See also col. 5 lines 55-col. 6

The limitation in new claim 31 for a hydroxy benzotriazole compound is met by the UV absorber of example 3 , a hydroxy benzoate derivative. Although, not the applicants exact derivative, since it is a hydroxy benzoate compound used by Beaver which acts as a UV absorber, one of ordinary skill in the art would have been motivated to make the modification using the benzotraizole of Beaver, because it provides the same function-- UV absorption, See line 24, and col. 4 lines 35-56.

It would have been obvious to one of ordinary skill in the art to combine the methods of producing artificial nail structures (especially the teaching that any size may created) by Beaver and compounds of Beaver in the compositions of Pagano. The motivation for combining the

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methods and compounds of Beaver and Pagano is given by the fact that they are chemically equivalent compositions with slight variations in the choices of accelerators and excipients. They provide structural and functional equivalence within the state of the nail art.

### *Double Patenting*

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

a timely filed terminal disclaimer in compliance with 37 CAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. a terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

6. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,772,988 in view of view of Beaver, US patent 5,830,442.

Pagano teaches a nail composition which comprises a combination of various alkyl methacrylates. Pagano teaches a combination of various alkyl methacrylates including such methacrylates represented from methyl methacrylate and butyl methacrylate, with muticarbonyl

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vinyl monomers such as acetoacetoxyethyl methacrylate and with acrylic acids, additional plasticizers, solvents, and U.V. absorbers in a nail composition.

The claims differ in that applicants amended claim 1 requires a thickness of greater than 10 mils. Beaver teaches that the nail compositions may be used to create a nail of the desired length, thickness and shape, see col. 2 lines 19-22. This limitation encompasses applicants thickness of greater than 10 mils, since Beaver describes that any thickness and shape may be used.

Beaver also teaches artificial nail compositions that comprise ethylenically unsaturated monomers with acetoacetoxyethyl methacrylate, ethylene glycol dimethacrylates. He teaches the addition of accelerators that are aliphatic tertiary amines such as an N,N-di lower alkyl p-toluidine. Beaver includes in his nail compositions. See examples 4-8, 16 and 18-21. See also col. 5 lines 55-col. 6

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome either by a showing under 37 CAR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application of any unclaimed subject matter prior to the effective U.S. filing date of the reference under 37 CAR 1.131.

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*Response to Arguments*

7. Applicant's arguments filed 11/18/99 have been fully considered but they are not persuasive. The applicant has argued that claim 1 is directed to a liquid artificial nail composition, and the claim preamble must be considered by the examiner when evaluating patentability. This argument is moot in light of the new grounds of rejection based on the combination of references shown in Pagano and Beaver, especially since Beaver demonstrates an artificial nail.

8. Applicant has argued that compositions are not equivalent compositions, because he states that a terpolymer having acetoacetoxyethyl methacrylate as one monomer component can be used to make nail enamel compositions does not make it obvious that the acetoacetoxyethyl methacrylate monomer can be used in a composition that is polymerized in situ right on the nail surface.

The examiner responds that the compositions use chemically equivalent compounds, ie acetoacetoxyethyl methacrylates with slight variations in the choices of accelerators and excipients. Since the compositions use the same compound. The compositions of Pagano and Beaver are different, however the ordinary skilled artisan would have been motivated to look in the nail enamel/nail composition art in order to find out what the general state of the art has accomplished.

9. In response to the double patenting rejection, it is noted that the new double patenting rejection applies, due to applicants amended claim 1.

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Applicant has not provided a showing under 37 CFR 1.132 to overcome the double patenting rejection, nor has a terminal disclaimer been presented. The double patenting rejection is still active.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CCAR1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CCAR1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Faulkner whose telephone number is (703) 305-4043. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Don Adams, can be reached on (703) 305-4043. The fax phone number for the organization where this application or proceeding is assigned is (703) 703-305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



D.S.F,

February 2, 2000